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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,059	01/11/2002	Satoshi Otsuka	204935-9001	6540

7590 10/24/2005

Michael Best & Friedrich LLC  
401 North Michigan Avenue  
Chicago, IL 60611

EXAMINER
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ADDY, ANTHONY S

ART UNIT	PAPER NUMBER
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2681

DATE MAILED: 10/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/044,059

Applicant(s)

OTSUKA, SATOSHI

Examiner

Anthony S. Addy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09/21/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date. _____  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.
2. Applicant's arguments, see pages 3-7, filed on September 21, 2005, with respect to the rejection(s) of claim(s) 3-6 under the final rejection have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of **Smith et al., U.S. Patent Number 6,333,973 (hereinafter Smith)**.

### *Claim Rejections - 35 USC § 103*

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Nagasawa, U.S. Patent Number 6,782,281 (hereinafter Nagasawa)** and further in view of **Smith et al., U.S. Patent Number 6,333,973 (hereinafter Smith)**.

Regarding claim 3, Nagasawa teaches a portable telephone set (see col. 3, lines 39-48 and Figures 1A-2B) comprising: a control means having a first operating mode for providing telephone functions (see col. 5, line 63 through col. 5, line 14 and Fig. 6; where a controller 22 for providing telephone functions is shown) and a second

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operating mode for providing additional functions (see col. 5, lines 17-25 and Fig. 6; where a controller 28 for providing a game function is shown); a radio communicating means linked with the control means and operable to send and receive radio communications with a base station in the first operating modes (see col. 5, line 63 through col. 5, line 10 and Fig. 6; where a radio communications section 21 coupled to controller 22 is shown) and de-energized in the second operating mode (see col. 6, lines 28-47 and it is obvious Nagasawa teaches the radio communicating means is de-energized in the second operating mode, since Nagasawa teaches when there is an incoming call and the caller information is displayed and when the call start button is not pressed but the start button for a pocket game is pressed, a message stored in memory in advance is sent to release the call, without forcibly suspending the pocket game [see col. 6, lines 28-47], thus it is obvious the transmitter and receiver of the portable telephone is in a de-energized state); a manipulating unit linked with the control means and including a telephone function stop key (see col. 6, lines 21-22, col. 4, lines 17-25 and Fig. 6; where a key operation area 26 constituting a manipulating unit linked with controller 28 is shown), the manipulating unit providing a stop signal to the control means that switches the control means between the first and second operating modes when the telephone function stop key is pressed (see col. 6, lines 5-25); and a display means linked with the control means for displaying various data (see col. 4, line 66 through col. 5, line 3, col. 5, lines 44-53 and Figures 2B & 12B), wherein the control means is operative to render the radio communicating means operative when a

predetermined time has passed after the control means receives the stop signal (see col. 6, line 5 through col. 7, line 4).

Nagasawa fails to explicitly teach the control means is operative to check whether a mail addressed to the telephone set is present on a mail server, and display a mail ICON indicative of the mail on the server on the display means.

Smith, however, teaches an integrated message center that graphically displays different types of received messages together to facilitate user viewing and manipulation of the messages without having to follow a series of menus, and wherein the integrated message center associates a message type indicator with each of the received notification messages based on the determined message type and displays on the display a portion of the received notification messages and the associated message type indicators (see abstract and col. 2, lines 26-45). Smith further teaches the integrated message center is a logical entity that resides in a mobile telephone and operates in conjunction with a network services provider to inform a user of the mobile telephone of an incoming and pending messages such as fax mail, email, voice mail, e.t.c and wherein the network services provider includes SMS server, interworking function server, voice mail server, fax mail server and email server for storing many of the messages awaiting retrieval by the user and notifies the user of the pending messages (see col. 3, lines 50-59, col. 4, lines 1-7, col. 5, lines 5-8 and Fig. 5). According to Smith, voice mail and email server sends a notification to a user of the mobile telephone about a pending mail addressed to the telephone set is present on a mail server, and display a mail icon indicative of the mail on the server on the display

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means (see col. 7, lines 40-56, col. 8, lines 1-10, col. 9, lines 36-60, col. 10, lines 38-56 and Figures 10 & 12).

It would therefore have been obvious to one of ordinary skill in the art at the time the invention was made to modify the telephone set of Nagasawa with the teachings of Smith, in order to provide a message notification means in a telephone that graphically displays different types of received messages together to facilitate user viewing and manipulation of the messages without having to follow a series of menus, and wherein the message notification means associates a message type indicator with each of the received notification messages based on the determined message type and displays on the display a portion of the received notification messages and the associated message type indicators as per the teachings of Smith (see abstract and col. 2, lines 26-45).

Regarding claims 4 and 5, Nagasawa teaches a portable telephone set (see col. 3, lines 39-48 and Figures 1A-2B) comprising: an additional function unit that provides at least one of a game and a music reproduction (see col. 5, lines 17-22, col. 6, lines 5-11 and Fig. 6; where a controller (28) for pocket game is shown for a portable telephone set); a communication function unit (see col. 4, lines 63-66, col. 5, lines 6-10 and Fig. 6; where a radio communications section 21 is shown of a portable telephone set); and a stopping means linked with the communication function unit and having a first stop mode for stopping operation of the communication function unit and in response to the stopping of the communication function unit being repeatedly operative for a predetermined time for checking the presence of one or more of an arriving call addressed to the telephone set and displaying an ICON relative thereto on a display

(see col. 6, line 13 through col. 7, line 4), and a second stop mode for holding the communication function unit in a de-energized state so that the additional function unit may operate without interruption from the communication function unit relative to an arriving call (see col. 6, lines 28-47 [i.e. the limitation, "communication function unit is in a de-energized state" is met by the teaching of Nagasawa that, "when there is an incoming call and the caller information is displayed, and when the call start button is not pressed but the start button for a pocket game is pressed, a message stored in memory in advance is sent to release the call, without forcibly suspending the pocket game [see col. 6, lines 28-47], thus it is clear the transmitter and receiver of the portable telephone is in a de-energized state]). Nagasawa further teaches a portable telephone set, wherein the ICON comprises one or more of a telephone number of a calling party for the arriving call (see col. 5, lines 44-47 and col. 6, lines 15-18).

Nagasawa fails to explicitly teach checking the presence of a mail addressed to the telephone set and displaying an ICON relative thereto on a display.

Smith, however, teaches an integrated message center that graphically displays different types of received messages together to facilitate user viewing and manipulation of the messages without having to follow a series of menus, and wherein the integrated message center associates a message type indicator with each of the received notification messages based on the determined message type and displays on the display a portion of the received notification messages and the associated message type indicators (see abstract and col. 2, lines 26-45). Smith further teaches the integrated message center is a logical entity that resides in a mobile telephone and

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operates in conjunction with a network services provider to inform a user of the mobile telephone of an incoming and pending messages such as fax mail, email, voice mail, e.t.c and wherein the network services provider includes SMS server, interworking function server, voice mail server, fax mail server and email server for storing many of the messages awaiting retrieval by the user and notifies the user of the pending messages (see col. 3, lines 50-59, col. 4, lines 1-7, col. 5, lines 5-8 and Fig. 5).

According to Smith, voice mail and email server sends a notification to a user of the mobile telephone about a pending mail addressed to the telephone set is present on a mail server, and display a mail icon indicative of the mail on the server on the display means (see col. 7, lines 40-56, col. 8, lines 1-10, col. 9, lines 36-60, col. 10, lines 38-56 and Figures 10 & 12). Smith further teaches the ICON comprises one or more of a telephone number of a calling party for the arriving call and a sender's address for the mail (see col. 8, lines 1-10, col. 9, lines 36-60, col. 11, lines 32-41 and Figures 10 & 12).

It would therefore have been obvious to one of ordinary skill in the art at the time the invention was made to modify the telephone set of Nagasawa with the teachings of Smith, in order to provide a message notification means in a telephone that graphically displays different types of received messages together to facilitate user viewing and manipulation of the messages without having to follow a series of menus, and wherein the message notification means associates a message type indicator with each of the received notification messages based on the determined message type and displays on the display a portion of the received notification messages and the associated message type indicators as per the teachings of Smith (see abstract and col. 2, lines 26-45).



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5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Nagasawa, U.S. Patent Number 6,782,281 (hereinafter Nagasawa)** and **Smith et al., U.S. Patent Number 6,333,973 (hereinafter Smith)** Smith et al., U.S. Patent Number 6,333,973 (hereinafter Smith) as applied to claim 4 above, and further in view of **Shimanuki, U.S. Patent Number 5,890,071 (hereinafter Shimanuki)**.

Regarding claim 6, Nagasawa in view of Smith teaches all the limitations of claim 4. The combination of Nagasawa and Smith fails to explicitly teach a stop switch that is interposed between a power supply and the communication function unit.

Shimanuki, however, teaches a radio telephone set with broadcast receiving functions, wherein the power supply section comprises: a power supply for outputting electric power for a receiving system of the telephone section, the tuner section and the other elements that need power supply; and power supply switches for switching electric power for the telephone section and the tuner section (see col. 3, lines 61-67 and Fig. 1; where power supply switches 22 & 23 interposed between a power supply 21 and communication function unit are shown).

It would therefore have been obvious to one of ordinary skill in the art to modify the radio telephone set of Nagasawa and Smith with Shimanuki, to include a stop switch that is interposed between a power supply and the communication function unit, in order to save power in a wait state by means of an intermittent receiving operation in which the power supply is switched on and off alternately.

***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Dillon, U.S. Patent Number 6,067,561 discloses an electronic mail notification system and method within a hybrid network that transmits notifications via a continuous, high-speed channel.

Skladman et al., U.S. Publication Number 2002/0159575 A1 discloses method and system for filtering notification of e-mail messages.

Gupte et al., U.S. Publication Number 2001/0034225 A1 discloses one-touch method and system for providing email to a wireless communication device.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony S. Addy whose telephone number is 571-272-7795. The examiner can normally be reached on Mon-Thur 8:00am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic  
Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Anthony S. Addy', with a large, stylized flourish extending from the end of the signature.

Anthony S. Addy  
October 14, 2005

A handwritten signature in black ink, appearing to read 'Temica M. Beamer', written in a cursive style.

TEMICA BEAMER  
PRIMARY EXAMINER